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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,129	05/31/2000	Scott T. Hughes	A0614	3846
35219 7590 03/16/2009 WESTERN DIGITAL TECHNOLOGIES, INC. ATTN: LESLEY NING 20511 LAKE FOREST DR. E-118G LAKE FOREST, CA 92630				
EXAMINER				
COPPOLA, JACOB C				
ART UNIT		PAPER NUMBER		
3621				
MAIL DATE		DELIVERY MODE		
03/16/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/585,129

**Applicant(s)**

HUGHES ET AL.

**Examiner**

JACOB C. COPPOLA

**Art Unit**

3621

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 23 October 2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Acknowledgements***

1. This action is in reply to the Remarks filed on 08 January 2009, hereinafter "09 Jan Remarks."
2. Claims 1-10 are currently pending and have been examined.
3. This Office Action is given Paper No. 20090304. This Paper No. is for reference purposes only.

***Information Disclosure Statement***

4. The Information Disclosure Statement filed on 23 October 2008 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 6-10 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.
7. Regarding claims 6-10:
  - a. These claims recite computer programs only. "Computer programs claimed as computer listings per se, *i.e.*, the descriptions or expressions of the programs, are not physical 'things.' They are neither computer components nor statutory processes, as they

are not 'acts' being performed." MPEP §2106.01 I. Because the claims recite only abstractions that are neither "things" nor "acts," the claims are not within one of the four statutory classes of invention<sup>1</sup>.

b. Additionally, Applicants' original specification expressly states "[t]he control module 304, the formatting module 308, the collection module 312, the identification database 316, and the advertisement database 320 comprise executable code that may contain procedures, definitional statements, and macros" (Specification, p. 6, l. 18-20). Because the claimed modules and databases may be interpreted as software only, the claims are not within one of the four statutory classes of invention and are therefore rejected under 35 U.S.C. §101.

c. Alternatively, and because the specification is not read into the claims (because applicant always has a chance to amend the claims), and because the Examiner has determined that the terms "module" and "database" have not been lexicographically defined by Applicants, the Examiner notes that using the broadest reasonable interpretation of "module" and "database," as noted below, the claimed modules and databases are interpreted as software *per se*. Because the broadest reasonable interpretation of "module" and "database" includes software *per se*, in addition to Applicants express statement that the modules and databases are software only, the

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<sup>1</sup> 35 U.S.C. §101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures, and composition of matter. The latter three categories define "things" (or products) while the first category defines "actions" (*i.e.*, inventions that consist of a series of steps or acts to be performed).

claims are not within one of the four statutory classes of invention and are therefore rejected under 35 U.S.C. §101.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Merriman et al. (U.S. 5,948,061 A) ("Merriman"), in view of Abgrall (U.S. 6,373,498 B1) ("Abgrall").

10. Regarding claims 1 and 6:

d. Merriman discloses *a method of operating a content delivery system for distributing advertising content* ("methods and apparatuses for targeting the delivery of advertisements") *to users of personal computers* (user's browser **16**), (figure 1, figure 2, and associated text).

- e. Additionally, Merriman discloses the following limitations:

i. *collecting identification data* ("user identification") *from a network of personal computers* ("the user is a computer on an IP Network" and "users") (C3, L24 - C4, L55; and figure 1 and associated text);

- ii. *receiving the advertising content (via "advertising process") from an advertiser (C4, L20+, figure 1, and associated text);*
- iii. *formatting the advertising content for storage ("advertisement... are stored within ad server process 19") and display in the personal computer (C4, L20+);*
- iv. *distributing, using the collected identification data, the formatted advertising content to the personal computers ("upon receiving") (C3, L52 and C4, L25-30); and*
- v. *wherein the personal computers are configured to periodically receive and store advertising content and display the advertising content (C4, L20+; C3, L52; and C4, L25-30).*
- f. Merriman does not specifically disclose the following limitations:
  - vi. *wherein the personal computers are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment.*
- g. Abgrall, however, teaches the following limitations:
  - vii. *wherein the personal computers (user computer 40<sub>1</sub> through user computer 40<sub>N</sub>) are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment ("content that was previously downloaded... is then displayed, **prior to loading and/or execution of the operating system**") (C3, L54 - C4, L31; and C9, L25+).*

- h. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the personal computers of Merriman to include the functionality of periodically receiving and storing advertising content and storing advertising content and displaying the advertising content while or before bootloading a user selected application environment, as disclosed by Abgrall. One would have been motivated to do so because "the boot-up and shut-down images as displayed by the OS are normally not useful to the user and merely contain routine messages. Since the time to boot up and shut down is sufficiently long for the system to display more informative images, it is desirable to be able to display images other than the standard logos of the operating system", such as advertisements (Abgrall, "Background"; and C3, L54 - C4, L31).
11. Regarding claims 2, 3, 7, and 8:
- i. Merriman/Abgrall discloses the limitations of claims 1 and 6, as described above. Merriman/Abgrall, further, discloses the limitations:
- viii. *wherein the identification data comprises a unique identifier ("IP Address")/internet protocol ("HTTP") that is associated with one of the personal computers ("the user is a computer on an IP Network" and "users") (C3, L24 - C4, L55).*
12. Regarding claims 4 and 9:
- j. Merriman/Abgrall discloses the limitations of claims 1 and 6, as described above. Merriman/Abgrall, further, discloses the limitations:

- ix. *receiving preference data from the personal computers* (“[t]he derive profile process **52** is how the advertisement server gathers information about individual users or TCP/IP networks for individual users”) (C3, L24 - C4, L55);  
*and*
- x. *selecting the advertisement data that is to be distributed, at least in part, based upon the received preferences* (“[i]ncluded in each message **23**... are: (i) the user’s IP address...” and “upon receiving the message **23**, the advertising server process **19** determines which advertisement or other object to provide to user’s browser”) (Merriman, C3, L5-63 and C4, L20+).

13. Regarding claims 5 and 10:

- k. Merriman/Abgrall discloses the limitations of claims 1 and 6, as described above. Merriman/Abgrall, further, discloses the limitations:

- xi. *associating a fee with data representative of the advertiser* (Merriman, C2, L59+); *and*
- xii. *storing the fee in a storage device* (Merriman, C2, L59+).

14. The Examiner finds that because claims 1-10 recite neither “step for” nor “means for,” the examined claims fail Prong (A) as set forth in MPEP §2181 I.. Because claims 1-10 fail Prong (A) as set forth in MPEP §2181 I., the Examiner concludes that all examined claims (*i.e.* claims 1-10) do not invoke 35 U.S.C. §112, 6th paragraph. See also *Ex parte Miyazaki*, 89 USPQ2d 1207, 1215-16 (B.P.A.I. 2008)(precedential).

15. With respect to claims 6-10, Applicant is reminded that “A system is an apparatus.” *Ex parte Fressola* 27 USPQ2d 1608, 1611 (B.P.A.I. 1993)(citations omitted). Additionally,



"[c]laims in apparatus form conventionally fall into the 35 U.S.C. § 101 statutory category of a 'machine.'" *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). In light of the above, it is the Examiner's position that Applicants' claimed system claims (*i.e.* claims 6-10) are considered apparatus, machine, or product claims.<sup>2</sup>

16. Regarding claims 6-10 and because of Applicants' choice to pursue these claims as product claims, Applicants are reminded that functional recitations using the word and/or phrases "for," "adapted to," or other functional language (*e.g.* see claim 6 which recites "a collection module *for* collecting... a formatting module *for* formatting") in the product claims have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. This is an alternative argument. To be especially clear, all limitations have been considered. However, a recitation of the intended use of the claimed product must result in a *structural* difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such a machine is to be utilized is not germane to the issue of patentability of the machine itself."); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115.

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<sup>2</sup> 35 U.S.C. §101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures and compositions of matter. The latter three categories define "things" (or products) while the first category defines "actions" (*i.e.*, inventions that consist of a series of steps or acts to be performed).

Unless expressly noted otherwise by the Examiner, the claim interpretation principles in the paragraph apply to all claims currently pending.

17. After careful review of the specification and prosecution history, the Examiner is unaware of any desire—either expressly or implicitly—by Applicants to be their own lexicographer and to define a claim term to have a meaning other than its ordinary and accustomed meaning. Therefore, the Examiner starts with the heavy presumption that all claim limitations are given their ordinary and accustomed meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) (“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”); *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002) (There is a “heavy presumption that a claim term carries its ordinary and customary meaning.”). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).<sup>1</sup>

18. In accordance with the ordinary and accustomed meaning presumption, during examination the claims are interpreted with their “broadest reasonable interpretation . . . .” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also MPEP §2111.

19. However, if Applicants disagree with the Examiner and have either (a) already used lexicography or (b) wish to use lexicography and therefore (under either (a) or (b)) desire a claim limitation to have a meaning other than its ordinary and accustomed meaning, the Examiner

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<sup>1</sup> It is the Examiner’s position that “plain meaning” and “ordinary and accustomed meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustomed meaning . . .”).

respectfully requests Applicants in their next response to expressly indicate<sup>2</sup> the claim limitation at issue and to show where in the specification or prosecution history the limitation is defined. Such definitions must be clearly stated in the specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term”).<sup>3</sup> The Examiner cautions that no new matter is allowed.

20. The Examiner finds that because examined claims 1-10 recite neither “step for” nor “means for,” the examined claims fail Prong (A) as set forth in MPEP §2181 I. Because all examined claims fail Prong (A) as set forth in MPEP §2181 I., the Examiner concludes that claims 1-10 do not invoke 35 U.S.C. §112, 6th paragraph. See also *Ex parte Miyazaki*, 89 USPQ2d 1207, 1215-16 (B.P.A.I. 2008)(precedential)(noting when Prong (A) is not met, the

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<sup>2</sup> “Absent an *express intent* to impart a novel meaning, terms in a claim are to be given their ordinary and accustomed meaning. [Emphasis added.]” *Wenger Manufacturing Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1232, 57 USPQ2d 1679, 1684 (Fed. Cir. 2001) (citations and quotations omitted). “In the absence of an *express intent* to impart a novel meaning to claim terms, an inventor’s claim terms take on their ordinary meaning. We indulge a heavy presumption that a claim term carries its ordinary and customary meaning. [Emphasis added.]” *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1380 (Fed. Cir. 2002) (citations and quotations omitted).

<sup>3</sup> See also *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), (“[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, *as long as* the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]”); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (“Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.”). See also MPEP §2111.01, subsection titled “Applicant May Be Own Lexicographer” and MPEP §2173.05(a) titled “New Terminology.”

results of Prongs (B) and (C) even if affirmative, will not invoke 35 U.S.C. §112, 6th paragraph since the applicant has an opportunity to amend the claims.

21. The Examiner notes that the “configured to” limitation of claim 1 does not constitute a method step. If Applicants desire “configured to” to mean ‘programmed to’ Applicants could have amended the claims to say as such.

22. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims.<sup>3</sup> Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

1. **database** “A file composed of records, each containing fields together with a set of operations for searching, sorting, recombining, and other functions.” (Computer Dictionary, 3<sup>rd</sup> Edition, Microsoft Press, Redmond, WA, 1997)<sup>4</sup>;

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<sup>3</sup> While most definitions are cited because these terms are found in the claims, the Examiner may have provided additional definitions to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

<sup>4</sup> Based upon Applicants’ disclosure, the art of record, and the knowledge of one of ordinary skill in this art as determined by the factors discussed in MPEP §2141.03 (where practical), the Examiner finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See e.g. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used the *Microsoft Press Computer Dictionary* (3d ed.) as “a technical dictionary” to define the term “flag.” See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971)(noting that its appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and MPEP §2173.05(a) titled ‘New Terminology.’

- m. **module** “1. In programming, a collection of routines and data structures that performs a particular task or implements a particular abstract data type. Modules usually consist of two parts: an interface, which lists the constants, data types, variables, and routines that can be accessed by other modules or routines; and an implementation, which is private (accessible only to the module) and which contains the source code that actually implements the routines in the module.” *Id.*
- n. **Computer**: “Any machine that does three things: accepts structured input, processes it according to prescribed rules, and produces the results as output.” *Id.* **Server**: “2. On the Internet or other network, a computer or program that responds to commands from a client.” *Id.* **Client**: “3. On a local area network or Internet, a computer that accesses shared network resources provided by another computer (called a server).” *Id.*
- o. **for** “1 a – used as a function word to indicate purpose.” (Webster’s Ninth New Collegiate Dictionary, Merriam-Webster, Inc., Springfield, MA, 1986);
- p. **configure** (vt –ured) “to set up for operation esp. in a particular way.” *Id.*
23. Additionally, the Examiner notes that “the PTO and the CCPA acknowledged product-by-process claims as an exception to the general rule requiring claims to define products in terms of structural characteristics.” *Atlantic Thermoplastics Co. v. Faytex Corp.*, 970 F.2d 834, 845, 23 USPQ2d 1481, 1490 (Fed. Cir. 1992) (hereinafter “*Atlantic Thermoplastics v. Faytex I*”). Furthermore, the Federal Circuit “acknowledges that it has in effect recognized . . . product-by-process claims as exceptional.” *Atlantic Thermoplastics v. Faytex I*, 970 F.2d at 847, 23 USPQ2d at 1491.

Because of this exceptional status, the Examiner has carefully reviewed claims and it is the Examiner's position that claims 1-10 *do not* contain any product-by-process limitations whether in a conventional format or otherwise. If Applicants disagree with the Examiner, the Examiner respectfully requests Applicants in their next appropriately filed response (i.e. their response is made of record) to expressly point out any product-by-process claim(s) and their limitations so that they may be afforded their exceptional status and treated accordingly. Applicants are reminded that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself." *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).<sup>5</sup> Failure by Applicants in their next response to also address this issue in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered intent by Applicants *not* to recite any product-by-process limitations. Unless expressly noted otherwise by the Examiner, the preceding discussion on product-by-process principles applies to all examined claims currently pending.

### ***Response to Arguments***

#### ***35 U.S.C. §101 Rejection***

24. Regarding claim 6, Applicants state "Each of these system or machine components performs described functions" (p. 4 of the 09 Jan Remarks). Applicants argue that their system claims have functional language. Applicants are reminded that functional language in product

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<sup>5</sup> See also MPEP §2113.

claims will not distinguish the claimed invention over the prior art when the prior art is capable of performing the recited function.

25. Regarding claim 6, Applicants state:

As set forth in MPEP § 2106.IV.B, “For example, a claimed invention may be a combination of devices that appear to be directed to a machine and one or more steps of the functions performed by the machine...an apparatus claim with process steps is not classified as a ‘hybrid’ claim, instead, it is simply an apparatus claim including functional limitations....”

09 Jan Remarks, pp. 4-5 (emphasis added by Applicants)

26. The Examiner acknowledges this citation. However, the source for this citation provided by Applicants is *R.A.C.C. Indus v. Stun-Tech, Inc.*, 178 F.3d 1309 (Fed. Cir. 1998) (unpublished). The USPTO is not bound by this decision because it is an “unpublished” decision.

27. Additionally, the Examiner concludes that there are not any “steps of the functions performed by the machine” found in claim 6. If there were method steps recited in claim 6, which is a system claim (see ¶ 15 above), then the claim would be rejected under 35 U.S.C. §112, 2<sup>nd</sup> Paragraph for being in ‘hybrid’ form. See MPEP §2173.05(p) II discussing hybrid claims.

28. Regarding claim 6, a system claim (see ¶ 15 above), Applicants cite *In re Bilski* (p. 5 of the 09 Jan Remarks). The Examiner acknowledges the citation. Because claims 6-10 are system claims and because *In re Bilski* applies to process claims, Bilski’s holding does not apply to claims 6-10.

29. Regarding claim 6, Applicants argue “the content delivery system of independent claim 6 clearly sets forth a particular system or machine that performs well-defined process steps and is

clearly statutory subject matter under 35 U.S.C. § 101” (p. 5 of the 09 Jan Remarks). The Examiner respectfully disagrees. First, as noted above, claim 6 does not contain any process steps, let alone “well-defined process steps.” Second, claim 6 is not statutory because using the broadest reasonable interpretation (and alternatively, as expressly stated by Applicants in their specification as originally filed) the “system” of claim 6 can be interpreted as software *per se* (see 35 U.S.C. §101 rejection above).

***Prior Art Rejections***

30. Regarding claims 1-10, Applicants argue “there is no teaching, suggestion, or rational reasoning set forth by the Examiner to combine Merriman and Abgrall, and thus, no *prima facie* case of obviousness has been adequately established” (p. 6 of the 09 Jan Remarks) (emphasis in original). The Examiner respectfully disagrees. In the rejection above, the Examiner gives a clear motivation to combine the references, as taught directly from the secondary reference.

31. Regarding claims 1-10, Applicants argue:

As recognized by the Examiner, on page 4 of the Office Action, Merriman does not disclose the following limitations: “*wherein the personal computers are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment.*”

09 Jan Remarks, p. 6 (emphasis in original)

32. The Examiner agrees that Merriman does not disclose this *entire* limitation. The Examiner, however, did show in the previous Office action (Paper No. 20080714), that Merriman does disclose “formatting the advertising content for storage and display in the personal computer” (see ¶ 12, c, iii) and “distributing, using the collected identification data, the



formatted advertising content to the personal computers” (see ¶ 12, c, iv). From these teachings (and from the citations provided by the Examiner), it is apparent to one of ordinary skill in the art that Merriman does disclose “wherein the personal computers are configured to periodically receive and store advertising content and display the advertising content.” The only teaching lacking from Merriman is displaying the advertising content *while or before bootloading a user selected application environment*.

33. Regarding claims 1-10, Applicants argue “Abgrall in no way relates to *personal computers that periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment*” (p. 7 of the 09 Jan Remarks) (emphasis in original). The Examiner respectfully disagrees. Abgrall discloses “the initial payload is stored... in ROM BIOS” (c. 3, l. 59-61) (emphasis added); “the initial payload is launched from ROM BIOS and displayed on the screen after the Power On Self Test (POST) but prior to the booting, loading and/or execution of the OS” (c. 3, l. 62-65) (emphasis added); and “Once copied, the payload executes after POST but prior to operation of the OS, and may display graphics, advertisements, animation... JPEG... formatted material on the screen” (c. 4, l. 4-9) (emphasis added).

34. As shown in the previous Office action, and as shown directly above, Abgrall clearly teaches *wherein the personal computers are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment*.

35. Applicants argue “There is no mention or description of advertisements at all in Abgrall,” (p. 7 of the 09 Jan Remarks) (emphasis in original). The Examiner respectfully disagrees.

Abgrall discloses “graphics, advertisements, animation...” (c. 4, l. 7) (emphasis added); and “the previously displayed messages or advertisements.” (c. 10, l. 28-29) (emphasis added).

36. Applicants argue:

[I]t is clear that the Examiner *has misinterpreted the teachings of* Abgrall and that Abgrall relates to the display of graphic display images during a transition of an operating system in a computer system and does not teach or suggests *personal computers that periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment*.

09 Jan Remarks, p. 7 (emphasis in original).

37. The Examiner respectfully disagrees. Again, the Examiner finds that Abgrall directly discloses displaying advertisements. Applicants arguments appear to recite broad claim recitations without particularly pointing out which *specific* claim element(s) are not found in the prior art.

38. Finally Applicants arguments do not address the Examiner's position that the rejection above is an *obviousness* rejection. An example will help illustrate the Examiner's point.

39. For example, suppose a hypothetical claim recites elements A, B, and C. Next suppose the hypothetical examiner rejected the hypothetical claim as being obvious with primary reference X in view of secondary reference Y where primary reference X discloses elements A and B while secondary reference Y discloses C. Arguing that the primary reference X does not disclose element C is not persuasive because the examiner is *not relying on the reference* for that particular claim element. Along the same lines of reasoning, arguing secondary reference Y does not disclose elements A and B is also not persuasive because again, the examiner is *not relying on the reference* for those particular claim elements. This hypothetical is similar to what Applicants are arguing in this particular application.

***Conclusion***

40. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

41. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

42. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other

aspects of patentability (e.g. §101 patentable subject matter, §112, 1<sup>st</sup> paragraph written description and enablement, §112, 2<sup>nd</sup> paragraph indefiniteness, and §102 and §103, prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

43. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work, Millennium Ed. By Ron White; How Networks Work, Bestseller Ed. By Frank J. Derfler et al.; How the Internet Works, Millennium Ed. By Preston Gralla; and Desktop Encyclopedia of the Internet by Nathan J. Muller, is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because these references are directed towards beginners (see e.g. “User Level Beginning...”), because of the references’ basic content (which is self-evident upon examination of the references), and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these references are primarily directed towards those of low skill in this art. Because these references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within these references.

44. Because this application is now final, Applicants are reminded of the USPTO’s after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. “The refusal of an examiner to enter an amendment after final rejection of

claims is a matter of discretion.” *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1<sup>st</sup> paragraph written description and enablement, §112 2<sup>nd</sup> paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

45. Applicants are reminded that patents are written by and for skilled artisans. See *e.g. Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) (“patents are written by and for skilled artisans”).<sup>1</sup> The Examiner therefore starts with the presumption that Applicants are skilled artisans who possess at least ordinary skill in the art. Consequently, it is the Examiner’s position that because the patent references of record are directed to those with ordinary skill in this art, these references are clear, explicit, and specific as to what they teach. Nevertheless some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process, and to help these applicants understand the contents of a reference when viewed

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<sup>1</sup> See also *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1371, 59 USPQ2d 1745, 1749-50 (Fed. Cir. 2001)(“patents are written for persons experienced in the field of the invention”).

from the position of one of ordinary skill in this art, Applicants are hereby given actual notice that if after reasonably reading any reference of record—whether the reference is currently of record or subsequently made of record—if Applicants can not reasonably understand or if Applicants have difficulty comprehending one or more sentence(s), statement(s), diagram(s), or principle(s) set forth in the reference(s), Applicants should (in their next appropriately filed response) bring this issue to the attention of the Examiner. In addition to bringing this issue to the attention of the Examiner, and in accordance with 37 C.F.R. §1.111(b), Applicants' response must also state *why* they either do not understand or *why* they have difficulty comprehending the offending reference(s). If after properly receiving (*i.e.* Applicants' response is made of record) both Applicants' request for understanding and the reasons as to *why* the request is made—and assuming the reference is germane to at least one outstanding rejection—the Examiner may either provide a substitute reference, or alternatively, do his best to elucidate the particular sentence(s), statement(s), diagram(s), or principles(s) in the offending reference. For all documents or references made of record after this Office Action, Applicants are given actual notice that this paragraph becomes effective when Applicants receive notice that the document or reference is made of record (*i.e.* this paragraph becomes applicable when Applicants submit an Information Disclosure Statement or when Applicants receive an examiner's Notice of References Cited (Form PTO-892)).

46. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on

Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

47. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

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March 4, 2009

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